

REMARKS

The Applicant acknowledges the withdrawal of the allowability of claims 7-15 in view of the new rejection.

The Examiner rejected claim 35 as being anticipated by Brinkhurst '452. The Applicant respectfully traverses the rejection. Brinkhurst '452 discloses a media storage container with unitary pages or a plurality hinged unitary pages. Nothing in Brinkhurst '452 discloses the page halves recited in claim 35. Claim 35 requires the claimed storage container to have a substantially rigid plastic page that is formed from first and second page halves that were separately formed and joined together to form the page. The page that is formed by the page halves is the one that is adapted to hold a pair of discs. To the contrary, Brinkhurst '452 discloses a single unitary page (13) adapted to hold a pair of discs or a plurality of unitary, double disc-holding pages (13) that are hingedly connected together (page 6, lines 21-25) – like the pages of a book. Nothing in Brinkhurst '452 discloses or suggests the structure of each of the pages. The page recited in claim 35 is thus significantly different than the Brinkhurst '452 pages described in the material cited by the Examiner. The Applicant has amended claim 35 in order to clarify that the recite page is formed from the two page halves. In addition, the Applicant has amended claim 35 to recite that the first and second page halves are non-pivotably connected. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP § 2131. The Applicant respectfully submits the structure of the page recited in claim 35 is not found in Brinkhurst '452. In addition, the Application submits Brinkhurst '452 does not

suggest a page structure similar to that recited in claim 35 and thus has no disclosure that renders the invention of claim 35 obvious. The Applicant thus respectfully submits claim 35 is patentable over the art.

The Examiner rejected claim 7 as being obvious in view of the combination of Brinkhurst '452 and US Patent 3,244,436 to McKowen. The Applicant respectfully traverses the rejection. The Examiner admits that Brinkhurst '452 does not disclose the use of a V-shaped edge on its pages to receive adhesive. The Examiner cites Fig. 1, item #12, of McKowen to support the contention that it is old and well known in the art to have a page edge in a V-shape to provide a pocket for an adhesive. The Applicant respectfully traverses the rejection. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestions or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. M.P.E.P. § 2142. The Applicant thus submits the Examiner has not established a *prima facie* case of obviousness for claim 7.

The Applicant notes that claim 7 requires the edge of the page to be V-shaped in cross section. The Applicant submits McKowen does not disclose the V-shaped page recited in the claim. McKowen discloses a traditional and well known type of book binding wherein signatures (12) are sewn (34) together and glued to a spine. In the book binding

art, a "signature" is "a large sheet printed with four or a multiple of four pages that when folded becomes a section of the book." Dictionary.com, second definition under "6. Printing." The "page 12" cited by the Examiner is actually a plurality of book pages with only the outer two pages (joined by fold) engaging the adhesive. The V-shaped gaps cited by the Examiner are formed between adjacent signatures 12 – not on the edges of the pages. Each page of McKowen's structure thus does not have an edge that is V-shaped in cross section as required by the claim. In fact, most of the McKowen pages do not touch the adhesive because they are disposed in the middle of a page bundle. In order to clarify the difference, claim 7 has been amended to recite that the V-shaped edge is indented into the page to define the pocket for the adhesive. This language matches the structure shown in the drawings and described in the specification. In view of the foregoing, the Applicant submits the cited combination of references does not render claim 7 obvious. The third requisite criteria has not been met because all of the claim limitations are not found in the two references. In addition, there is no suggestion in either reference for modifying the Brinkhurst flat edged page to the V-shaped edge recited in the claim. The Applicant thus respectfully submits independent claim 7, and its dependent claims, are patentable over the art.

The Examiner has rejected independent claims 27 and 30 as being obvious in view of the combination of Brinkhurst '452 and Gelardi '782. The Applicant respectfully traverses the rejections. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestions or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a

reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. M.P.E.P. § 2142. The Applicant thus submits the Examiner has not established a prima facie case of obviousness for claims 27 or 30.

Claims 27 requires the page of the media storage container to be formed by the page halves in the same manner as claim 35. The Applicant's explanation of the differences between these page halves and the Brinkhurst reference are incorporated herein by reference. Without the disclosure of the page halves recited in claim 27, the Brinkhurst/Gelardi combination does not include all of the limitations of claim 27 and thus cannot be used to establish a prima facie case of obviousness. Furthermore, the Gelardi tab teachings cited by the Examiner to disclose the location of a literature card do not suggest the claimed literature card configuration. Gelardi discloses that a literature card may be on one side of disc-holding page – not within the page. Claim 27 requires the card to be disposed between the first and second page halves – inside the page itself – and between the discs. Gelardi's tabs do not provide the suggestion or motivation necessary to establish a prima facie case of obviousness for the invention of claim 27. Nothing in the two references suggests to one of ordinary skill in the art to locate a literature card between first and second page halves as recited in claim 27. The Applicant thus submits that claim 27, and its dependent claims, are patentable over the art.

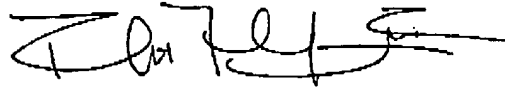
Claim 30 requires the outer perimeter of the disc-holding page to be positioned directly between the front and rear paperboard cover members when the cover members

are closed. The Brinkhurst '452 reference discloses a paperboard cover disposed inwardly of the outer perimeter of the front and rear cover members such that the edges of the cover members are protected from wear and so that the cover member may wrap around the spine edge of the page in between Brinkhurst's clips 23 and 24. Brinkhurst '452 also teaches that the cover members are to abut the disc holder (13) (page 8, line 22). Brinkhurst '452 thus teaches away from the arrangement recited in claim 30. The Applicant thus submits that the teachings of Gelardi – or any other reference – would be not reasonably combined with Brinkhurst '452 to achieve the invention recited in claim 30. Further, the Examiner has not identified any material in Gelardi that discloses the cover configuration recited in the claim. The Applicant thus submits that claim 30 is patentable over the cited combination of references.

In view of the patentability of the independent claims, the Applicant submits the rejections of the dependent claims are obviated. The Applicant submits no further response to the dependent claim rejections is necessary at this time.

In addition, the Applicant maintains his interpretation of Brinkhurst '452 teaching away from the claimed connection between the page and cover members. Brinkhurst discloses that although such connections are possible, they are undesirable and mechanical connections are preferred.

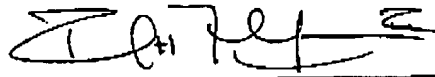
In view of the foregoing, the Applicant respectfully requests reconsideration of the claims and most earnestly solicits the issuance of a formal notice of allowability for the claims.



By: Fred H. Zollinger, III
Reg. No. 39,438
Zollinger & Burleson, Ltd.
P.O. Box 2368
North Canton, OH 44720
phone 330-526-0104
FHZ
Attorney Docket: 1949-A-CIP

CERTIFICATE OF FACSIMILE

I hereby certify that this correspondence (Amendment F in application serial no. 09/883,619 filed June 18, 2001) is being transmitted via facsimile to 1-571-273-8300 on January 26, 2006.



Fred H. Zollinger III
Reg. No. 39,438